

REMARKS / ARGUMENTS

Claims 1-4, 6, and 8-38 are currently pending in this application. The Office Action has deemed claim 7 (which was never presented) canceled and Applicants have canceled claim 5. Claims 31-38 are new.

The Office Action has rejected claims 1-4, 9-11, 14, 18-19, and 27-30 under 35 U.S.C. 102(e), as anticipated by U.S. Patent No. 5,983,196 to Wendkos (hereafter “Wendkos”). The Office Action has rejected claims 5-6 and 8 under 35 U.S.C. 103(a), as being obvious over Wendkos and matters officially noticed. The Office Action has rejected claims 23-26 as being obvious over Wendkos in view of the U.S. Patent No. 5,768,382 to Schneier et al. (hereafter “Schneier”) And the Office Action has rejected claims 12 and 13 as being obvious over Wendkos in view of the U.S. Patent No. 5,644,727 to Atkins (hereafter “Atkins”). Finally, the Office Action has rejected claims 15-17 and 20-22 as being obvious over Wendkos in view of the U.S. Patent No. 5,231,568 to Cohen et al. (hereafter “Cohen”).

Amendments

Applicants have amended their claims 1 and 2 to include a limitation as to web pages comprising GUI controls that result in calls to a centralized server. Applicants have made clerical amendments to dependent claims 6 and 30.

Official Notice/Publications

As noted above, the Office Action used Official Notice, along with Wendkos, to reject claims 5-6 and 8. In particular, with respect to claim 5, the Office Action took Official Notice that “the use of webpage to display information from the Internet on a client computer is extremely old and well known in the art”. And, with respect to claims 6 and 8, the Office Action took Official Notice that “the utilization of HTML standard and Java script are exceptional old and well known technologies for the creation of web pages”.

Unfortunately, the quoted findings is that they do not have a reference point with respect to time. As noted in the Applicants' Application Data Sheet, the Applicants claim domestic priority, in part, back to November 14, 1996, which is the filing date of U.S. Patent No. 5,816,918 (the '918 patent). Applicants believe that web pages and HTML were not extremely or exceptionally old and well known technologies at that time. For instance, the famous Amazon "one-click" patent (U.S. Patent No. 5,960,411) was not filed until September 12, 1997, and cites numerous non-patent references on virtual shopping carts from 1996. Consequently, Applicants traversed these statements of Official Notice in response to the Office Action's non-final rejection and continue to traverse them in this response.¹

As noted in MPEP 2144.03, findings of fact must be based on substantial evidence in order to comply with the Administrative Procedures Act. In this case, the Office Action has not provided such evidence with respect to the matters described in the quoted statements. Furthermore, these matters do not involve peripheral issues, but rather limitations which distinguish the Applicants' claims from the disclosure in Wendkos. Wendkos describes a network devoid of GUIs, for example. Therefore, these matters are not a proper subject for official notice, as explained in MPEP 2144.03(A). Moreover, merely raising the specter of Official Notice does not allow an adequate assessment of the propriety of a combination. A combination of a reference with Official Notice does not allow one to consider aspects of the combination which may teach away from the combination in question, for example.

In a similar vein, the Office Action states that (1) "a plurality of servers in communication over an Internet network to provide interactive features to a user/player" equates to a "website" and that (2) further arguments against such an equation are not

¹ Applicants traversed these Officially Noticed findings on page 5 of their response of July 11, 2007. However, the Office Action contends that Applicants' traversal was somehow inadequate. Applicants respectfully disagree. Each of the above-quoted findings consisted of a single sentence. A challenge to the entire sentence was adequate to indicate which facts required documentary proof. See MPEP §2144.03(C).

presently supported “absent any defining criteria of a website”. See page 9 of the Office Action mailed on October 16, 2007. The Schneier patent actually includes a lengthy glossary which defines a “website” as ‘any computer connected to the Internet which is capable of being accessed via the World Wide Web’. See column 52, lines 49-50. This definition (albeit somewhat recursive) contradicts the equation made by the Office Action.

While Schneier does not ultimately provide the last word on interpretation of the claims of the present application, it does provide context in which one having ordinary skill in the art would consider the claims. A contrary definition would be a minimum to support a rejection of the website based on the evidence of Schneier. The Internet is not the same thing as the World Wide Web. See the Webopedia article on *The Difference Between the Internet and the World Wide Web*² attached as Appendix A and admissible as a publication under MPEP 716.02(g). As explained in that article, the World Wide Web is a subset of the Internet’s physical network which uses the HTTP protocol, rather than other Internet protocols such as FTP or SMTP. Note, Wendkos nowhere describes any Internet protocols.

Anticipation and Obviousness

The legal standard for anticipation is well settled. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A similar legal standard applies to obviousness: “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”

As noted earlier, Applicants claim domestic priority, in part, back to November 14, 1996. For example in this regard, see column 18, line 60 to column 19, line 40 and Figures 6b and 6c of the ‘918 patent, which discuss a prize redemption system which might comprise

the Internet, the World Wide Web, web pages, HTML, and Java, in some embodiments. However, the filing date for the Wendkos patent is December 18, 1996, over a month after the filing date of the ‘918 patent.

The Wendkos patent does claim priority to “U.S. Provisional Application Ser. No. 60/008,873, filed Dec 19, 1995 by Brad Wendkos”. Applicants obtained a copy of that provisional patent from the Patent Office’s archives and have attached it hereto as Appendix B. A cursory review of the provisional patent shows that it describes a system that runs on a “public switched telephone network”. The provisional patent nowhere mentions the World Wide Web, the Internet , or any other computer network.³ Consequently, in reference to the present application, the effective filing date for the Wendkos patent appears to be its actual filing date, i.e., December 18, 1996. See MPEP 706.02(VI)(D).

Further, as also noted earlier, Applicants have amended claims 1 and 2. Claim 1 now includes a limitation that the system’s video selection interface screen comprises “one or more web pages with one or more GUI controls whose associated events result in calls to a centralized server”. Similarly, claim 2 now includes a step which allows redemption of prizes from websites displaying “one or more web pages with one or more GUI controls whose associated events result in calls to one or more centralized servers”.

As the Office Action apparently admits, the Wendkos patent teaches nothing about websites, web pages, GUI controls, GUIs, or even computer graphics. At most, the Wendkos patent describes some functionality related to an interactive computer game with an award. However, an interactive computer game need not include functionality for generating computer graphics or images, though we presently tend to associate one with the other. An example of such a game is the text-based adventure game “Colossal Cave Adventure”, designed by Will Crowther.⁴

²Downloaded from http://www.webopedia.com/DidYouKnow/Internet/2002/Web_vs_Internet.asp on January 28, 2008.

³ The provisional patent does use the term “POP”. However, the context of that use shows that “POP” stands for “Point of Purchase” rather than “Post Office Protocol”. In this regard, see also Figure 1 in the provisional patent.

⁴ As to Colossal Cave Adventure, see generally, http://www.rickadams.org/adventure/a_history.html.

Furthermore, since the Wendkos patent is silent with respect to GUIs and/or GUI controls, the Wendkos patent is perforce silent with respect to events from those controls resulting in calls to a centralized server. Yet all of the Applicants' claims now include limitations with respect to such events. Consequently, the Wendkos patent neither anticipates nor supports a prima facie case of non-obviousness against these claims.

For the foregoing reasons, Applicants believe that all claims are now in condition for allowance. If the Examiner believes that a telephone conference would expedite the further prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully Submitted,
TIPS GROUP

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/Glenn E. Von Tersch/
Glenn E. Von Tersch, Reg. No. 41,364